

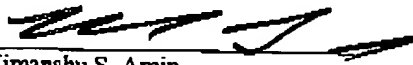
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PATENT

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OFFICIAL**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:

Applicant(s): Charles P. Thacker *et al.*

Examiner: Cesar B. Paula

Serial No: 09/410,414

Art Unit: 2178

Filing Date: October 1, 1999

Title: DYNAMICAL PAGINATION FOR ELECTRONIC DOCUMENTS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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REPLY BRIEF

Dear Sir:

Applicants' representative submits this reply brief in response to the Examiner's
Answer mailed June 30, 2004.

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REMARKS

This is in Reply to the Examiner's Answer dated June 30, 2004. It is respectfully submitted that various contentions asserted in the Examiner's Answer as well as previous arguments made by the Examiner in connection with rejection of claims of the subject application are without merit. The below-noted comments re-address and further emphasize deficiencies of the Examiner's bases for relying on the cited art in connection with rejecting claims of the subject patent application.

I. Barker et al. fails to teach or suggest a segment as recited in the subject claims.

Barker *et al.* does not teach or suggest a segment as recited in independent claims 1, 6, 12, 20, 23, 26, and 30. The Examiner's Answer contends that "Barker teaches the insertion of an object into a document. The rest of the document, which is contained in the current page, and the following pages [is a] predetermined segment." (See Examiner's Answer, pg. 9). Additionally, in the Advisory Action dated Mar. 16, 2004, it is argued that "a paragraph, and a page fits the definition of what a segment is." (See Advisory Action, pg. 2).

However, such definitions are not consistent with the claimed invention, in view of the claims as a whole. The definition of "a segment" as construed should be consistent throughout the claim. (See *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851 (Fed. Cir. 2001) ("a claim term should be construed consistently with its appearance in other places in the same claim or in other claims in the same patent."); *Digital Biometrics, Inc. v. Identix, Inc.* 149 F.3d 1335, 1345 (Fed. Cir. 1998) ("[T]he same word appearing in the same claim should be interpreted consistently.")). More particularly, independent claims 1, 6, 20, and 30 recite *a plurality of segments*. The definition of segment suggested in the Examiner's Answer is inoperable, since there is only one "segment" comprising the "the current page, and the following pages" after the location of the insertion of an object. The beginning, ending and content there between of this "segment" are determined by the location where the object is inserted. Thus, there cannot be a plurality of such "segments" as recited in the subject claims, since "another

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segment" with the same beginning, ending and content there between is the same "segment."

Moreover, a page does not satisfy the definition of a segment in view of the claim limitation *determining a plurality of page breaks within a predetermined segment* as recited in independent claims 1, 6, 20, 23, and 30. Such a definition creates a nonsensical result – that a plurality of page breaks are determined within a page. Thus, Barker *et al.* does not teach or suggest a segment as recited in the subject claims. Additional deficiencies of the suggested definitions for segment are noted *infra*.

- ii. *Barker et al. fails to teach or suggest determining a plurality of page breaks within a predetermined segment as recited in the subject claims.*

Barker *et al.* does not teach or suggest determining a plurality of page breaks within a predetermined segment as recited in independent claims 1, 6, 20, and 23 (and similarly independent claim 30). The following contentions are presented in the Examiner's Answer:

Barker teaches the insertion of an object into a document page. The rest of the document, which is contained in the current page, and following pages – *predetermined segment* – is then reformatted, which then causes a portion of the document, having data such as a superblock, to be repaginated and moved to the top of the next page, and this causes the following pages to be repaginated as well. An unformatted page is formatted or repaginated before display. In other words, *the rest of the document is repaginated* by moving or pouring the reformatted document portion (rest of the document) into following pages.

(See Examiner's Answer, pg. 9) (emphasis added) (citations omitted). Therefore, Barker *et al.* discloses pagination of an entire document and/or remainder of a document subsequent to a location of an inserted object rather than pagination of a *predetermined segment* as recited in the subject claims. Applicants respectfully disagree with the contention that "the rest of the document ..." after the insertion of an object is the "predetermined segment" as recited in the subject claims. As noted *supra*, such a

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definition is not consonant with other language of the claims, since there cannot be more than one "rest of the document" (in view of the claim language reciting plurality of segments). Moreover, assuming that the suggested definition of a page or paragraph is utilized for "segment" as noted *supra*, the contentions in the Examiner's Answer highlight the distinctions between the subject invention and Barker *et al.* because the *rest of the document is repaginated*, and not merely paginating the predetermined segment as recited in the subject claims.

On the contrary, the subject claims recite determining a plurality of page breaks *within* a predetermined segment. Within is defined as "inside the fixed limits of; not beyond." (See The American Heritage Dictionary, 4th Edition). Thus, the present invention determines the page breaks *inside the fixed limits of, and not beyond* the predetermined segment. Thus, Barker *et al.* fails to teach or suggest such aspects recited in the subject claims.

iii. Barker et al. fails to teach or suggest processing a document of at least text as a plurality of segments as recited in the subject claims.

Barker *et al.* does not teach or suggest processing a document of at least text as a plurality of segments as recited in independent claims 1 and 20. The Examiner's Answer contends that "this argument was not submitted before prosecution was closed. Therefore, this new argument presented herein is also considered conceited [sic], since the appellant did not previously raise this argument based on the rejections addressed on paper 8." (See Examiner's Answer, pg. 8). It appears the Examiner is incorrectly applying rules of evidence and civil procedure employed by the judiciary at an appellate level in connection with the subject administrative agency action. More particularly and contrary to the Examiner's assertions regarding applicants' conceding to various positions regarding deficiencies of the cited art, there is no proscription prohibiting additional arguments to be made in the appeal brief to further emphasize the lack of a *prima facie* case of anticipation or obviousness made by the Examiner *via* the cited art *vis a vis* applicants' claimed invention. Notwithstanding the foregoing, it is respectfully submitted that the argument made regarding Barker *et al.* failing to teach or suggest processing a document of at least text as a plurality of segments was presented during prosecution and

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that the Examiner failed to properly consider such argument, thus requiring yet further clarification *via* the appeal brief.

Assuming, *arguendo*, that these arguments have been conceded, the subject claim language nonetheless should be considered in view of the suggested meaning of segment noted in the Examiner's Answer. (*See Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851 (Fed. Cir. 2001) ("a claim term should be construed consistently with its appearance in other places in the same claim or in other claims in the same patent."); *Digital Biometrics, Inc. v. Identix, Inc.* 149 F.3d 1335, 1345 (Fed. Cir. 1998) ("[T]he same word appearing in the same claim should be interpreted consistently.")). As noted *supra*, the Examiner's Answer proposes that a segment is "the rest of the document" after the location of an inserted object. (*See Examiner's Answer*, pg. 9). Therefore, by way of example, if a superblock on the fifth page of a one-hundred page document is edited and causes the rest of the document to be repaginated, then the "segment" is from the fifth page through the one-hundredth page. Thus, there cannot be a *plurality* of such "segments" because any other "segment" from page five (the location of the edited / inserted object) through page one-hundred is the same "segment." Accordingly, *Barker et al.* fails to teach or suggest processing a document of at least text as a plurality of segments as recited in the subject claims.

iv. Barker et al. does not teach or suggest dynamically paginating as recited in the subject claims.

Barker et al. fails to teach or suggest dynamically paginating as recited in independent claims 6 and 12. In the Examiner's Answer, the following is contended:

The appellants submit ... that *Barker* teaches static pagination, and not pagination at the time of display based on the characteristics of the display device. This argument was not submitted before prosecution was closed, because appellants stated in the response for reconsideration filed on 6/17/2003 regarding office action in paper 8, that *Barker* does not teach the processing and/or entering and/or pouring a predetermined document segment, determination of a plurality of page breaks in a document segment, and the *dynamic pagination of a document segment*.

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Therefore, this new argument presented herein is considered conceited [sic], since the appellant did not previously raise this argument based on the rejections addressed on paper 8.

(See Examiner's Answer, pg. 7-8) (emphasis added) (citations omitted). Applicants respectfully disagree with such assertion and believe there is a lack of support for mandating the concession of arguments in the MPEP, CFR and USC as noted *supra*. Assuming, *arguendo*, that such contentions are valid, the response to paper 8 did contain an argument related to Barker *et al.* failing to teach or suggest dynamically paginating a document (as noted *supra* in the Examiner's Answer). (See Reply to Office Action dated April 10, 2003, pg. 11). This argument was presented during prosecution and the Examiner failed to properly consider such argument, thus requiring yet further clarification *via* the appeal brief. More particularly, it stems from this argument to contrast dynamic pagination with the static pagination technique employed in Barker *et al.*

As noted in the specification, dynamic pagination refers to "determining only the page breaks within the text of an electronic book *a priori*, and not to, for example, actually laying out each page within the text *a priori*." (See Specification, pg. 12, ln. 1-4). This is consistent with the claim language that recites rendering a predetermined page within the predetermined segment in independent claims 1 and 20. In contrast, Barker *et al.* utilizes static pagination where page break locations are determined while creating or after editing a document (*see* col. 12, ln. 1-67), and not at the time of display based on the characteristics of the display device. Thus, Barker *et al.* does not teach or suggest dynamically paginating as recited in the subject claims.

- v. ***Barker et al. fails to teach or suggest pouring text of the segment into a series of predetermined slots of a page organized into at least one column of the page, until the slots of the page have been processed as recited in the subject claims.***

Barker *et al.* fails to teach or suggest pouring text of the segment into a series of predetermined slots of a page organized into at least one column of the page, until the

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slots of the page have been processed as recited in independent claims 12 and 26. The Examiner's Answer contends:

This is *basically* done by Barker, when the rest of the document is repaginated, because part of the document will no longer fit in a current page. This condition forces the overflow portion of the document to be moved onto the next page. Then, if the remaining document is unformatted (doesn't fit in the next page), then the document is repaginated or moved onto a next page until all the remaining portion of the document has been repaginated with page breaks.

(See Examiner's Answer, pg. 10) (emphasis added) (citations omitted). Applicant respectfully disagrees with such contentions and additionally restates the standard by which anticipation should be evaluated.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes *each and every limitation* set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Thus, Barker *et al.* *basically* teaching such aspects does not satisfy this standard, since each and every limitation set forth in the subject claims is not taught or suggested. More particularly, the subject claims recite *pouring text of the segment into a series of predetermined slots of a page*. As noted in the specification, pouring is employed to determine how much text will fit onto a page. (See pg. 10, ln. 16-17). Barker *et al.*, on the contrary, relates to flowing text, whereby text is positioned around an object. (See col. 15, ln. 25-38). Barker *et al.* is silent regarding determining how much text will fit

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onto a page and thus, fails to teach or suggest pouring text of the segment into a series of predetermined slots of a page as recited in the subject claims.

CONCLUSION

The present application is believed to be in condition for allowance, in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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